

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

Applicant's invention is a smart connector; i.e. the connector having the capability of inserting a circuit board with at least one intelligent circuit component between input (or supply) and output wires in, for example, a wiring harness. The connector comprises two mating and latchable bodies each of which is provided with channels and terminal devices in the channels so that circuit connections can be made to and through the circuit board by each of the two connector bodies.

Claims 1 - 3, and 5 - 11 have been rejected under 35 U.S.C. § 103(a) as unpatentable over Jozwiak et al. (U.S. Patent No. 5,668,698). Jozwiak et al. shows a smart connector having two matable and latchable bodies 10 and 180 capable of capturing an L-shaped circuit board 54 there between. Harness wires 11 come into the terminal, but nothing goes out; i.e., the left end of the arrangement shown in Fig. 1 terminates in a relay 182.

The Examiner recognizes that Jozwiak et al. has a number of shortcomings relative to claimed elements; e.g., Jozwiak et al. does not show the plurality of wire channels in the second connector body. Looking at the amended claim it will also be clear that Jozwiak et al. does not show conductive terminal devices in those wired channels for making connections between external wires and the circuit board as set forth in claim 1. Similar language is contained in claim 7, i.e., the overall content of claim 7 is such as to make it quite clear that the printed circuit board represents a junction between input and output conductors; note the word "intermediate" in the preamble of claim 7.

The Examiner takes the position that it would have been "obvious" to provide all of the missing elements including the wire channels in the second conductor body simply because they are present in the first conductor body. He cites *St. Regis Company v. Bemis*, 193 U.S.P.Q. 8, a 1977 case which relies on *Sakraida v. Ag Pro., Inc.*, 425 U.S. 273 for the proposition that combinations of old elements are not patentable in the absence of "synergy". The Examiner puts a slightly different spin on it, saying that there is no invention in putting wire channels in one of the two connector bodies if they are in the other.

Applicants submit that this is not the law. *Sakraida's* concept that there is a special rule for combination inventions is discredited in *Jervis B. Webb Co. v. Souther Systems*, 742 F.2d 1388, 222 U.S.P.Q. and *In re Wright*, 848 F.2d 1216, 6 U.S.P.Q.2d 1959 (Fed. Cir. 1988). Jozwiak et al. has no wire channels in relay 180

because, Jozwiak et al. is not a "through connection" device; it is a termination which happens to include a circuit board. There is no reason to put wire channels in relay 180.

Moreover, Applicants believe that the Examiner is taking impermissible liberties with the recitation of a "second conductor body" to correspond to Jozwiak et al.'s relay. The relay has terminals 184 for insertion into the receptacles 62 of the circuit board and there is no reason apparent from the reference itself to provide Jozwiak et al. with "a plurality of wire channels".

The Examiner also appears to appreciate that Jozwiak et al. does not show the notch in the circuit board but further suggest that this would be obvious as involving a mere "rearrangement of parts". Again, Applicants respectfully submit that it is incumbent upon the Examiner to cite prior art in support of a rejection. The prior art must deal with the exact point of asserted novelty; it is neither permissible nor appropriate for the Examiner to take judicial notice or rely on his own personal opinion. Applicants have already cited *In re Lee* and reiterates reliance on that case. In addition, Applicants refer the Examiner to the ruling of *Ex Parte Cady*, 148 U.S.P.Q. 162, a 1964 decision of the Patent Board of Appeals to the effect that the Examiner must cite art and cannot rely on judicial notice at the exact point of personal novelty. A similar decision is *In Re Spormann and Heinke*, 150 U.S.P.Q. 449, a 1966 decision of the Court of Customs and Patent Appeals.

Applicants observe that the Examiner has made no comment on the limitations of claims 3 and 5 pertaining to the position assurance device and the latching mechanism. Jozwiak et al. provides no express or implied support for the proposition that a position assurance device having the recited features could be used in the Jozwiak et al. arrangement. The mere fact that terminal position assurance devices are known in the art does not suffice since the record is devoid of evidence to show that such devices are use to hold circuit boards in smart connectors.

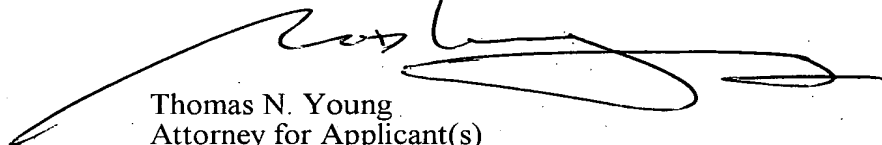
Applicants propose to amend claim 7 to incorporate the subject matter of claims 9 and 10 and to cancel those claims as superfluous. Applicants also propose to amend claim 8 where it appears that the "first" and "second" reference to the terminal bodies are the opposite of those used in claim 1. These are not amendments which raise new issues; they deal directly with issues the Examiner raises in the last Office Action.

In summary, it is respectfully submitted that the rejection of claims 1-3, and 5-11 under 35 U.S.C. § 103 is improperly constructed as there are no teachings in the references themselves to support the Examiner's conclusion that it would be

obvious to add any of the list of missing features. Applicants propose to amend claims 1, 7 and 8 to make the points of distinction even clearer, but the claims appear to be clear of the prior art with or without the amendments. Therefore, the amendments do not per se raise new issues of patentability and it is incumbent upon the Examiner to reconsider these claims in light of the arguments made herein as part of the prosecution of this the original application. An advisory action consistent with 37 C.F.R. § 1.136(a) is requested.

Respectfully submitted,

YOUNG & BASILE, P.C.

A handwritten signature in black ink, appearing to read 'Tom Young', is written over the printed name and title of the attorney.

Thomas N. Young
Attorney for Applicant(s)
Registration No. 20,985
(248) 649-3333

3001 West Big Beaver Rd., Suite 624
Troy, Michigan 48084-3107

Dated: December 13, 2004
TNY/sem